



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,846	12/21/2000	J. Francis Russel	50N3777.01	2168

27774 7590 12/28/2004

MAYER, FORTKORT & WILLIAMS, PC
251 NORTH AVENUE WEST
2ND FLOOR
WESTFIELD, NJ 07090

EXAMINER

BARQADLE, YASIN M

ART UNIT	PAPER NUMBER
----------	--------------

2153

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,846

Applicant(s)

RUSSEL, J. FRANCIS

Examiner

Yasin M Barqadle

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2153

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 12, 2004 has been entered.

Response to Amendment

2. The amendment filed on October 12, 2004 has been fully considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

Art Unit: 2153

art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen US (5794217) in view of Kolling et al US (6385595).

As per claim 1, Allen teaches a method for preparing graphical content associated with corresponding digital audio content, comprising (fig. 1 and abstract):

receiving said graphical content associated with said corresponding audio digital content from a digital database [col. 5, lines 26-45 and col. 9, lines 34-51]; and

preparing said graphical content for packaging with said corresponding digital audio content with a compact disk containing said corresponding digital audio content (col. 6, lines 38-55 and col.8, lines 1-55) by implementing at least one format conversion [col. 6, lines 38-55 and col. 11, line 38-62].

Although Allen shows substantial features of the claimed invention as explained above, he does not explicitly show a software program for manipulating and creating both postscript and PDF files.

Nonetheless, these applications are well known in the art and would have been an obvious modification of the system

Art Unit: 2153

disclosed by Allen, as evidenced by Kolling et al USPN.

(6385595).

In analogous art, Kolling et al whose invention is about preparing electronic statement that includes audio, full motion video, graphics, images and custom enclosure, disclose a template authoring system that utilizes of-the-shelf software program (packages) for manipulating, converting and creating both postscript and PDF files [Col. 9, lines 53 to col. 10, line 25]. Giving the teaching of Kolling et al, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Allen by employing of-the-shelf software packages taught by Kolling et al for their ubiquitous use in desktop publishing and printable materials and for their support in creating, editing and converting file formats (i.e., converting Postscript to PDF [col. 10, line 1-25]).

Kolling teaches printing said (PDF) files [col. 19, lines 40-57].

As per claim 2, Allen teaches the method according to claim 1, wherein said receiving step comprises downloading said graphical content from said digital database [col. 5, lines 26-45 and col. 6, lines 38-55].

Art Unit: 2153

Kolling as modified teaches a first software program with a format compatible to graphical content [col. 10, lines 11-25].

As per claim 3, Kolling et al teach the method according to claim 2, wherein the first software program includes Quark Xpress [col. 23, lines 10-25].

As per claim 5, Kolling et al teach the method according to claim 2, wherein the first software program includes Acrobat Distiller [col. 10, lines 11-16].

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do

Art Unit: 2153

not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipate by Allen US (5794217).

As per claim 25, Allen teaches a method for transmitting media to a consumer over a public computer network comprising:

transmitting a digital media file over the computer network to a user's personal computer in response to user's request for the digital media file [digital media file is transmitted to a consumer in a remote location col. 5, lines 26-45 and col. 9, lines 26-51]; and

receiving the digital media file and the graphics file at the user's personal computer [col. 10, line 62 to col. 11, line 62 and col. 5, lines 26-45]; and

converting the graphic files to a printable format after receiving it [the received data is reformatted to printable format col. 6, lines 38-55 and col. 11, line 38-62];

printing the graphics file and attaching the printed

Art Unit: 2153

graphics to the computer readable medium [printing a graphic output and producing a duplicate of a title on a media useable by a consume col. 6, lines 38-55].

Conclusion

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

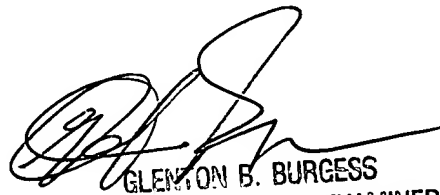
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Yasin Barqadle

Art Unit 2153


GLENN B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100